

Amendments to the Drawings

Please accept replacement sheets 1- 3 (these sheets include Figures 1-4). The replacement sheets are each marked "Replacement Sheet" and amended to correct the wording at the top of each sheet, which should read as follows:

300202694-2 US
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Method and System for Authoring Content

REMARKS

Reconsideration of the application is respectfully requested in view of the amendments and the discussion presented below. The amendments are supported by the application as filed and no new matter has been added by any of the amendments.

Claim 7 was *inadvertently omitted* from the previous claims listing and is included in the current listing.

Claims 11 and 18 are amended to include a missing preposition, thus: "at least one binding element which defines the identity and location of at least a portion of content."

The drawings are amended to correct the wording at the top of each sheet of drawings.

Claims 1-14 and 18 are now present in this application.

Discussion

A Withdrawal of Objections and Rejections

The Examiner is thanked for expressly indicating that the objections to the specification and to claim 1 and the rejections under 35 U.S.C. §§ 101, 102(e), and 103(a) have been withdrawn.

B. The Objection to the Drawings

The drawings have been amended by providing replacement sheets with corrected titles having all the letters of the inventor's name. The objection to the drawings should be withdrawn.

C. The Objection Concerning Claim 7

Claim 7 was inadvertently omitted from the last listing of claims. It is presented in the current listing and should not be cancelled.

D. The Rejection of Claims 1-6, 8-14, and 18 under 35 U.S.C. § 103(a)

The Examiner rejected claims 1-6, 8-14, and 18 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Publication 2002/0156815 to Davia ("Davia") in view of the article to Duhig ("Duhig"). The rejection is respectfully traversed for the reasons given below.

The Applicant submits that the Examiner has **not** established a *prima facie* case of obviousness for the claims rejected under 35 U.S.C. § 103(a). The Applicant notes:

"To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

M.P.E.P. at § 2143. The Applicant submits that a *prima facie* case of obviousness has not been established at least because the Examiner has failed to show that Davia and Duhig teach each and every element as claimed in the present application.

Claim 1

Claim 1 is an independent claim and requires:

1. (previously presented) A method of authoring content to be served by a server comprising:

authoring on a computing device a layout document which defines at least one area of a document which includes the content to be published;

authoring on a computing device [1] **at least one binding element which defines the identity and location of at least a portion of content and at least one style description which defines a style to be applied to a selected portion of content;**

[2] **in which the step of authoring the layout document includes allocating to the at least one defined area a director to at least one binding element such that when processed the published document includes in the defined area the content as directed by the binding element in the style as directed by the binding element.**

(emphasis supplied).

Neither Davia nor Duhig teach or suggest a binding element "which defines the identity and location of at least a portion of content and at least one style description which defines a style to be applied to a selected portion of content." The Examiner agrees that Davia "fails to teach the use of a binding element for identifying a portion of content." Office Action at page 4. The Examiner cites Duhig as providing a teaching of "authoring on a computing device at least one binding element which defines the identity and location of at least a portion of content and at least one style description which defines a style to be applied to a selected portion of content." Id. at page 4. Specifically, the Examiner states that Duhig discusses W3C standard X-pointers in the context of "out-of-line linking" and mentions that an X-pointer "is used to address fragments of another document." Id. at pages 4. Thus, "Davia teaches a layout information file that is separate from the content information. Duhig teaches the use of XLink with XPointer to define out-of-line linking for content information located elsewhere such as third-party linking. At the time of the invention it would have been obvious to include a binding element to reference a portion of content." Id. at page 5.

The specification of the instant application teaches that XML extensible mark-up language may be used to carry out the method of the invention in producing a set of data structured according to a set of rules. See page 9, line 21 to page 10, line 10, and page 10, line 24

to page 13, line 36. Duhig is merely a discussion of linking using XML, XLink, and XPointer, with a discussion of out-of-line linking.

Duhig does not teach or suggest that XPointers may be used to address either content or style of a document. The Examiner, however, notes that the *Applicant* (the Examiner specifically mentions "fig 4 of applicants drawings") uses XPointers to reference content in one file and style in another file. *Id.* at page 4-5. The Examiner is referring to the binding elements 402 and 403 disclosed in the preferred embodiment and indicated on Figure 4 of the drawings.

It is not acceptable to use the Applicant's disclosure of his own invention in the specification as a reference against him. The Examiner essentially argues that because the Applicant teaches the use of XML and XPointers in practicing the preferred embodiment, the prior existence of these tools makes the limitation obvious. Under this logic, if the Applicant first taught and claimed building a house using tools such as a saw, hammer, drill, etc., the Examiner would reject the claimed subject matter because the tools were already known and the motivation was provided by the Applicant's disclosure (build a house).

Neither Davia nor Duhig teach or suggest "at least one binding element which defines the identity and location of at least a portion of content and at least one style description which defines a style to be applied to a selected portion of content" when the disclosure of the Applicant's preferred embodiment is not used as a reference against him. Furthermore, neither Davia nor Duhig teach or suggest styles at all. Neither Davia nor Duhig teach or suggest "the step of authoring the layout document includes allocating to the at least one defined area a director to at least one binding element such that when processed the published document includes in the defined area the content as directed by the binding element in the style as directed by the binding element." Neither reference mentions styles, of course. Again, the Examiner has argued that because tools such as XML, XLink, and XPointer are known and the motivation is provided by the Applicant, the use of the known tools to accomplish the Applicant's purpose is obvious. This is improper reasoning to support a *prima facie* case of obviousness.

For at least these reasons, the Examiner has not established that **the references when combined teach or suggest all the claim limitations**. A *prima facie* case of obviousness therefore has not been established for claim 1. The section 103(a) rejection of claim 1 should be withdrawn.

Claims 11, 14, and 18

Claims 11, 14, and 18 are the other independent claims pending in this application. Although directed to a data structure embodied in a computer-readable medium (claims 11 and 14) or a system for authoring content to be served (claim 18), these claims all contain the "binding element" limitation: "at least one binding element which defines the identity and location of at least portion of content and at least one style description which defines a style to be applied to a selected portion of content." As discussed above, "binding elements" are not taught or suggested by Davia in view of Duhig. The Examiner therefore has not established that the references when combined teach or suggest all of the limitations of any of these claims.

A *prima facie* case of obviousness therefore has not been established for claims 11, 14, and 18. The Section 103(a) rejection of claims 11, 14, and 18 should be withdrawn.

Claims 2-10, 12, and 13

Claims 2-10 depend from independent claim 1 directly (claims 2, 3, and 5-10) or indirectly (claim 4). Claims 12 and 13 depend from independent claim 11. Independent claims 1 and 11 are allowable over the Davia and Duhig references as explained above. For at least this reason, the Section 103(a) rejection of the dependent claims should be withdrawn.

Conclusion

Claims 1-14 and 18 are allowable because the rejections over 35 U.S.C. § 103(a) and the objections to the drawings and the claims (claim 7) have been overcome as described above.

In view of the above, the Applicant submits that the application is now in condition for allowance and respectfully urges the Examiner to pass this case to issue. The Examiner is invited to telephone the undersigned attorney as needed in order to advance the examination of this application.

* * *

The Commissioner is authorized to charge any additional fees which may be required or credit overpayment to deposit account no. 08-2025. In particular, if this response is not timely filed, then the Commissioner is authorized to treat this response as including a petition to extend the time period pursuant to 37 CFR 1.136(a) requesting an extension of time of the number of months necessary to make this response timely filed and the petition fee due in connection therewith may be charged to deposit account no. 08-2025.

I hereby certify that this correspondence is being deposited with the United States Post Service with sufficient postage as first class mail in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on


Respectfully submitted,

September 27, 2006
(Date of Transmission)

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